UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,171	04/09/2001	George M. Brookner	26978A-006610US	9225

77196   7590   11/25/2008
Townsend and Townsend and Crew LLP
Two Embarcardero Center
San Francisco, CA 94111-3834

EXAMINER
ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
11/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	09/829,171	BROOKNER ET AL.
Office Action Summary	Examiner	Art Unit
	AKIBA K. ROBINSON BOYCE	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *16 October 2008*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3,5,9,10,12-16,19,20 and 24-38* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1, 3, 5, 9, 10, 12-16, 19, 20, and 24-38* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

10/16/08 has been entered.

Status of Claims

2.   Due to communications filed 10/16/08, the following is a non-final office action.

Claims 1, 3, 5, 9, 10, 14, 16, 20, 25-27, 29 and 36-38 have been amended. Claims 2, 4,

6-8, 11, 17, 18, and 21-23 have been cancelled. Claims 1, 3, 5, 9, 10, 12-16, 19, 20,

and 24-38 are pending in this application, and have been examined on the merits. The

previous rejection has been adjusted to reflect claim amendments. Claims 1, 3, 5, 9,

10, 12-16, 19, 20, and 24-38 have been rejected as follows.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1, 3, 5, 9, 10, 12, 13, 14, 15, 16, 19, 20, 24, 25, 26, 27, 28, 29, 30, 31, 32,

33, 34, 35, 36, 37, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

DeFilippo et al (US 6044364), and furthering view of Eddy et al (US 5,812,400).

As Per Claim 1, DeFilippo et al discloses:

upon power-up of the postal device, transmitting from the postal device to a

remote server location information of the postal device, wherein the location

information of the postal device is transmitted automatically by the postal device

without any user interaction/ determining, at the remote server, a postal zip code

representing the location of the postal device based with a previously stored zip

code representing a previously stored location of the postal device, (Fig. 3, and col.

7, line 66-Col. 8, line 45, shows upon power up, zip code information is checked, the

postage meter requests zip code data for portable vault/printhead module, and the

data center ultimately downloads the appropriate zip code data to base

microprocessor, where in this case, the base micro processor represents the remote

server since it is necessary for a microprocessor to have a server to access

necessary data files).

comparing at the remote server the present zip code with a previously stored zip

code representing a previously stored location of the postal device, (col. 5, lines 25-32,

zip code data (data indicative of location) stored is checked to see if it matches a zip

code data store in NVM of printhead module prior to authorizing printing of the

requested postage amount on a mailpiece); and

when the present postal zip code of the device matches the previously stored zip code representing the previously stored location of the postal device, transmitting to the device from the remote device an authorization to use the funds; when the present postal zip code of the device does not match the previously stored zip code representing the previously stored location of the postal device, transmitting to the postal device from the remote server…inhibiting use of the funds stored in the postal device, (col. 5, lines 25-47, when a match occurs, printing of postage authorized, if a match does not occur, preventing the printing of postage by the postage metering system);

DeFilippo et al does not specifically disclose the transmission of a signal, however does disclose that Signals from motion encoder are sent to printhead module to coordinate the energizing of individual printhead elements col. 4, lines 47-49, thereby showing that a signal is needed for use of the printhead elements of the meter, and therefore suggesting signals indicating usage of the meter.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to produce a signal inhibiting use with the motivation of providing an indication that the meter can not be used.

DeFilippo et al does not specifically disclose determining a present physical location/ present zip code representing the present location of the postal device/, however, does disclose determining a location in the form of a zip code as described in col. 7, line 66-Col. 8, line 45. However, Eddy discloses a method of initializing a value metering device, where the value metering device to establish communications with a

remote data center and the user entering into the value metering device order

identifying data associated with the user ordering said value metering device and user

account identifying data, and upon the data center determining that the order identifying

data and the account identifying data are valid communicates to the value metering

device data relating to the physical location of said metering device in col. 2, lines 25-

39. In col. 10, line 58-col. 11, line 4, Eddy also discloses that for certain postal

authorities, a digital token is required to contain information concerning the physical

location of the electronic postage of the metering system because of licensing

requirements wherein a particular meter is licensed to be operated in a particular

location, as for example within a particular zip code area, the originating postal code of

the mailer, and that the metering system accommodates this requirement and enables

the utilization of an external smart card from originating zip locations other than that the

of the license location for the metering system. It therefore would be obvious to combine

the teachings of DeFilippo et al and Eddy to disclose determining a present physical

location/present zip code representing the present location of the postal device.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to disclose determining a present physical location/present zip

code representing the present location of the postal device with the motivation of

determining at what location funds associated with the particular postal device can be

used.

As per claim 15, DeFilippo et al discloses:

further comprising transmitting from the remote server to the postal device a zip

code corresponding to the present location of the postal device, (col. 7, line 66-Col. 8,

line 45, shows upon power up, zip code information is checked, the postage meter

requests zip code data for portable vault/printhead module, and the data center

ultimately downloads the appropriate zip code data to base microprocessor).

As per claims 9,10,12, 27, DeFilippo et al does not specifically disclose the following,

however does disclose securely communicating with data center 10 via a modem in col.

3, lines 49-53, which therefore suggest the following:

wherein transmitting comprises transmitting the present physical location information

over a telephone line/wherein transmitting comprises transmitting the present

physical location information over an internet connection/wherein transmitting

comprises transmitting the present location information over a cellular telephone

system/ further comprising determining the present postal zip code representing the

physical location of the device based on a location identifier of the cellular telephone

system.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to transmit via telephone line, internet or cellular telephone

system with the motivation of securely transmitting data over a network.

As per claims 13, 14, 30, 35, DeFilippo et al doesn't explicitly disclose: wherein

transmitting comprises transmitting the present location information based on an output

of a position determining apparatus of the postal device/wherein the position

determining apparatus is a global positioning system receiver and the present physical

location comprises global positioning system coordinates of the postal device/wherein

the location generator is a global position system receiver, but does disclose

geographical location/limitations in Col. 8, lines 35-43, which suggests that an actual

GPS system is not used but a locator system is capable of functioning in the same

manner as the GPS.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to include a device that is associated with a GPS system in

conjunction with a locator system within the system taught by Eddy's with motivation if

locating a device using Global Positioning System to operate the system more

efficiently.

As per claims 16, 36, DeFilippo et al discloses:

a memory for storing a value indicative of the funds/a memory for storing an

amount of funds;

a communication port accessible by the host processor, (col 4, line 57, non-volatile

memory);

a location generator for generating location information of the postal device/ and a

location generator that provides…, upon powering up, indicating the actual location of

the device to the remote server via the communication port and the host processor.,

(col. 7, line 66-Col. 8, line 45, shows upon power up, zip code information is checked);

a communication port for providing communication between the postal device and

a remote server, (col. 4, lines 24-34, establishes communication); wherein

the location information is transmitted via the communication port to the remote

server automatically upon power-up of the postal device and without any user

interaction, (Fig. 3, and col. 7, line 66-Col. 8, line 45, shows upon power up, zip code

information is checked, the postage meter requests zip code data for portable

vault/printhead module, and the data center ultimately downloads the appropriate zip

code data to base microprocessor, where in this case, the base micro processor

represents the remote server since it is necessary for a microprocessor to have a

server to access necessary data files);

an authorization is received via the communication port from the remote

server to use the postal device and the stored funds when the location of the postal

device as described by the location information indicates the location of the postal

device is within a preauthorized region of operation, and …by the postal device via the

communication port from the remote server inhibiting use of the postal device and the

stored funds when the location of the postal device indicates that the location of the

postal device is outside the preauthorized zip code within which the postal device is

authorized for operation/inhibiting use of the postal device and the stored funds when

the location of the postal device indicates that the location of the postal device is outside

the zip code within which the postal device is authorized for operation, (col. 5, lines 25-

32, zip code data (data indicative of location) stored is checked to see if it matches a zip

code data store in NVM of printhead module prior to authorizing printing of the

requested postage amount on a mailpiece, w/col. 5, lines 25-47, when a match occurs,

printing of postage authorized, if a match does not occur, preventing the printing of

postage by the postage metering system).

DeFilippo et al does not specifically disclose the transmission of a signal,

however does disclose that Signals from motion encoder are sent to printhead module

to coordinate the energizing of individual printhead elements col. 4, lines 47-49, thereby

showing that a signal is needed for use of the printhead elements of the meter, and

therefore suggesting signals indicating usage of the meter.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to produce a signal inhibiting use with the motivation of providing

an indication that the meter can not be used.

DeFilippo et al does not specifically disclose determining a present physical

location/ present zip code representing the present location of the postal device/,

however, does disclose determining a location in the form of a zip code as described in

col. 7, line 66-Col. 8, line 45. However, Eddy discloses a method of initializing a value

metering device, where the value metering device to establish communications with a

remote data center and the user entering into the value metering device order

identifying data associated with the user ordering said value metering device and user

account identifying data, and upon the data center determining that the order identifying

data and the account identifying data are valid communicates to the value metering

device data relating to the physical location of said metering device in col. 2, lines 25-

39. In col. 10, line 58-col. 11, line 4, Eddy also discloses that for certain postal

authorities, a digital token is required to contain information concerning the physical

location of the electronic postage of the metering system because of licensing

requirements wherein a particular meter is licensed to be operated in a particular

location, as for example within a particular zip code area, the originating postal code of

the mailer, and that the metering system accommodates this requirement and enables

the utilization of an external smart card from originating zip locations other than that the

of the license location for the metering system. It therefore would be obvious to combine

the teachings of DeFilippo et al and Eddy to disclose determining a present physical

location/present zip code representing the present location of the postal device.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to disclose determining a present physical location/present zip

code representing the present location of the postal device with the motivation of

determining at what location funds associated with the particular postal device can be

used.

As per claim 20, DeFilippo et al discloses:

a local device for securely storing the funds and outputting a proof of postage

indicuim, comprising: a memory for storing value indicative of the funds and a postal

drop off location, (col 4, line 57, non-volatile memory);

a location generator for generating present postal drop off location information of the

local device, (col. 7, line 66-Col. 8, line 45, shows upon power up, zip code information

is checked);

a communication port for providing communication between the local device and a

remote server, (col. 4, lines 24-34, establishes communication);

wherein the communication port transmits the present postal drop off location

information to the remote server automatically upon power-up of the device and without

any user interaction, (Fig. 3, and col. 7, line 66-Col. 8, line 45, shows upon power up,

zip code information is checked, the postage meter requests zip code data for portable

vault/printhead module, and the data center ultimately downloads the appropriate zip

code data to base microprocessor, where in this case, the base micro processor

represents the remote server since it is necessary for a microprocessor to have a

server to access necessary data files);

the remote server, comprising:

a database storing a preauthorized region of operation including postal drop off

location for the local device, (col. 2, line 54-col. 3, line 10, shows structure for storing

second data)

wherein:

the remote server compares a present postal drop off location of the local device

provided by the present location information to the preauthorized region of operation,

(col. 5, lines 25-32, zip code data (data indicative of location) stored is checked to see if

it matches a zip code data store in NVM of printhead module prior to authorizing printing

of the requested postage amount on a mailpiece);

the remote sever issues an authorization to the local device to allow it to use

the funds if the present postal drop off location of the local device is within the

preauthorized region of operation, the remote server … to the local device inhibiting use

of the funds if the present postal drop off location of the local device is outside the

preauthorized region of operation (col. 5, lines 25-32, zip code data (data indicative of location) stored is checked to see if it matches a zip code data store in NVM of printhead module prior to authorizing printing of the requested postage amount on a mailpiece, w/col. 5, lines 25-47, when a match occurs, printing of postage authorized, if a match does not occur, preventing the printing of postage by the postage metering system); and

DeFilippo et al does not specifically disclose the transmission of a signal, however does disclose that Signals from motion encoder are sent to printhead module to coordinate the energizing of individual printhead elements col. 4, lines 47-49, thereby showing that a signal is needed for use of the printhead elements of the meter, and therefore suggesting signals indicating usage of the meter.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to produce a signal inhibiting use with the motivation of providing an indication that the meter can not be used.

As per claim 26, DeFilippo et al does not specifically disclose the following, however does disclose secure communication with data center 10 via a modem in col. 3, lines 49-53, therefore making the following obvious:

determining the present postal zip code representing the present physical location of the device based on a network address of the device.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine the present location based on the network address of

the device with the motivation of using Internet resources to track the device's

transmitted data.

   As per claims 3, 24, 29, 33, 34, DeFilippo et al does not specifically disclose the

following, however does disclose secure communication with data center 10 via a

modem in col. 3, lines 49-53.

However, Eddy discloses a system for identifying the physical location of devices

where:

when the present physical location of the postal device is not within the previously

stored zip code representing the previously stored location of the postal device, issuing

a license for the device to use the funds at the present physical location of the

device/transmitting from the remote server to a postal carrier a request for a new

location license/wherein the communication port receives from the remote server a

license to use the funds at the present physical location of the postal device from the

remote server when the location information indicates that the present physical location

of the postal device is outside the preauthorized region of operation/ wherein the

communication port receives from the remote server a license permitting the local

device to use the funds the local device is outside the preauthorized region of operation/

wherein the remote server requests the license from a postal carrier, (col. 10, lines 58-

67, licensing requirements). Eddy et al discloses this limitation in an analogous art for

the purpose of showing that meters are licensed to be operated in a particular location.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to issue a license for the device to use the funds at the present

location if the location of the device is not within the predetermined region with the

motivation of maintaining eligibility for operating the device.

As per claim 5, DeFilippo et al discloses:

further comprising transmitting from the remote server to the postal device a zip

code, corresponding to the present physical location of the postal device, (Fig. 3,

and col. 7, line 66-Col. 8, line 45, shows upon power up, zip code information is

checked, the postage meter requests zip code data for portable vault/printhead

module, and the data center ultimately downloads the appropriate zip code data to

base microprocessor, where in this case, the base micro processor represents the

remote server since it is necessary for a microprocessor to have a server to access

necessary data files).

As per claims 19, 28, 31, 32, DeFilippo et al does not specifically disclose the

following, however does disclose secure communication with data center 10 via a

modem in col. 3, lines 49-53.

However Eddy teaches that identifying the dispense postage and location

identifier which indicates the amount while being verified by the postal authority to

authenticate the authenticity of the transaction in column 11, lines 19-45. In addition,

while Eddy doesn't explicitly mention digitally signing. Digitally signing relates to

verification and verification is met when the postal authority examines the transaction.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to include a device that is capable of digitally signing said

communication for the reasons of distributing funds or assessing funds by via of postal

authority authorization to make the system more efficient for operation.

As per claim 25, DeFilippo et al does not specifically disclose the following, however

does disclose secure communication with data center 10 via a modem in col. 3, lines

49-53.

However, Eddy discloses:

further comprising determining the present postal zip code representing the present

physical location of the device based on caller identification information, (col. 6, lines 18-

57). Eddy discloses this limitation in an analogous art at the time of the applicant's

invention for the purpose of showing that telephone numbers are included in

determining the meter location.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's

invention to determine the postal drop off location of the device based on caller

identification information with the motivation of providing location through telephone

number.

As per claims 37 and 38, DeFilippo et al does not specifically disclose the following,

however does disclose a display in col. 4, lines 21-24.

However, Eddy discloses:

whereby the present postal zip code representing the present physical location is

displayed by the device/whereby the device location may be displayed by the device.

(col. 2, lines 40-46, displaying location data). Eddy discloses this limitation in an

analogous art for the purpose of showing that location data is displayed for a meter

system

It would have been obvious to one of ordinary skill in the art at the time of the applicant's

invention for the device location code/location to be displayed with the motivation of

allowing a user to view location data.

Response to Arguments

5.   Applicant's arguments filed 10/16/08 have been fully considered but they are not

persuasive.

        Applicant argues that DeFilippo Fails to Disclose a Present Physical Location as

Recited in the amended claims. However, as now disclosed in the rejection, the

combination of DeFilipo and Eddy disclose this limitation. Although DeFilippo et al does

not specifically disclose determining a present physical location/present zip code

representing the present location of the postal device, DeFilippo does disclose

determining a location in the form of a zip code as described in col. 7, line 66-Col. 8, line

45. However, Eddy specifically discloses a method of initializing a value metering

device, where the value metering device to establish communications with a remote

data center and the user entering into the value metering device order identifying data

associated with the user ordering said value metering device and user account

identifying data, and upon the data center determining that the order identifying data

and the account identifying data are valid communicates to the value metering device

data relating to the physical location of said metering device in col. 2, lines 25-39. In col.

10, line 58-col. 11, line 4, Eddy also discloses that for certain postal authorities, a digital

token is required to contain information concerning the physical location of the

electronic postage of the metering system because of licensing requirements wherein a

particular meter is licensed to be operated in a particular location, as for example within

a particular zip code area, the originating postal code of the mailer, and that the

metering system accommodates this requirement and enables the utilization of an

external smart card from originating zip locations other than that the of the license

location for the metering system. It therefore would be obvious to combine the teachings

of DeFilippo et al and Eddy to disclose determining a present physical location/present

zip code representing the present location of the postal device.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

571-272-6734. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

•Patent Application Information Retrieval (PAIR) system, Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

A. R. B.
November 21, 2008

/Akiba K Robinson-Boyce/
Primary Examiner, Art Unit 3628